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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,796	03/15/2004	Mark G. O'Donnell	ODONNELL.7374	9194
7590 11/10/2005			EXAMINER	
William E. Hilton, Esq. Gauthler & Connors, LLP 225 Franklin Street, Suite 2300 Boston,, MA 02110			BRINSON, PATRICK F	
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/800,796

Applicant(s)

O'DONNELL ET AL.

Examiner

Patrick F. Brinson

Art Unit

3754

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 37 (2<sup>nd</sup> occurrence)-52 have been renumbered 38-53.

Claims 38-48 are objected to because of the following informalities: Claims 38-48 all depend from cancelled claim 36. The dependency should be changed.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 38, 42, 43 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 1,435,311 to Knight.

The patent to **Knight** discloses a flexible tubular clamping jacket, having an elongated protector length that is adapted to be readily applied to the cores of different sizes and characters, with the cores having a protected length the same as the protector length. The jacket functions to protect cylindrical objects about which it is placed. The jacket is a single layer of abrasion resistant material, formed of rubber tubing or similar elastomeric materials and is split length wise, with its edges being possessed of a strong, inherent, inwardly coiling or rolling and gripping tendency, thus allowing it to accommodate itself to cores of different diameters. Col. 2, lines 89-92, discloses that in some cases where the core is not large enough to expand the tube to its maximum capacity the edges (11 and 13) will overlap each other, as illustrated in fig. 3 and still grip and bind the core. The device of **Knight** has the same structure as the recited invention with the exception of not explicitly illustrating the jacket providing a plurality of overlapping layers to completely envelope a core once a force is provided that is greater than the gripping force. Fig. 1 discloses the jacket with an overlap that is substantially greater than that shown in fig. 3, yet there is still space provided within as shown by opening to accommodate a member. The difference between the jacket of **Knight** and the present invention is a function of size. If a rope or webbing smaller than the size of the tubing shown in fig. 1 were placed within the jacket, i.e., if a rope or webbing having an outer diameter substantially the same size as the opening shown in fig. 1 were placed within the jacket of **Knight**, the jacket would provide, in

use, sufficient overlap of the rope or webbing to completely envelop it from damage once the edge (13) is lifted by a force stronger than that which makes it coil inwardly. Likewise, the jacket itself could be formed including greater width, which would accommodate cores of even greater diameter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the jacket of **Knight**, increasing its width in order to accommodate a larger diameter core so as to provide a plurality of overlapping wraps to completely envelope and protect the core once the edge of the outer overlapping wrap is forced opened, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. As to the recitation of the jacket sliding sideways along a rough, hard surface, **Knight** does not disclose the jacket as being utilized in such an environment, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

3. Claims 39, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight**.

The patent to **Knight** does not specifically disclose the inner diameter of the protector, nor its weight. At the time the invention was made, it would have been an

obvious matter of design choice to a person of ordinary skill in the art to form the protector to have a inner diameter of 0.8 cm or no more than 2.5 cm and to have a weight of less than 2.5 ounces because Applicant has not disclosed that having a diameter of no more than 0.8 cm and a weight of less than 2.5 ounces provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well as disclosed without specific mention of diameter and weight as it is disclosed that the diameter will vary depending on the diameter of the core placed within it and it would not appear that the weight of the device is such as to prevent it from being easily packaged. Therefore, it would have been an obvious matter of design choice to modify the device of **Knight** to obtain the invention as specified in claims 39, 40 and 45.

4. Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of U.S. 4,929,478 to **Conaghan et al.**

The patent to **Knight** discloses the recited subject matter, but does not disclose the protector formed into square or triangular spiral shapes. The patent to **Conaghan et al.** discloses a protective sleeve for pipe or wires. Col. 4, lines 67-68 and col. 5, lines 1-4 disclose that although tubular articles having substantially cylindrical cross-section are illustrated in the drawings, other cross sections, including

rectangular, square, or triangular may be set into the fabric by the use of dies or mandrels of the desired shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cross section of the sleeve of **Knight** to not only have a circular cross-section, but a square or a triangular cross section, as suggested by **Conaghan et al.** in order to accommodate cores having a triangular or square shaped cross-section.

5. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of U.S. 4,181,157 to **DeCamp**.

The patent to **Knight** discloses the invention as discussed in the preceding paragraph with the exception of disclosing the material from which it is made as being a heat settable material. The patent to **DeCamp** discloses a sleeve formed of a flexible, heat settable material that is wrapped around itself, as well as the core upon which it's placed at least one and a half times. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the material of which the sleeve of **Knight** is made to be formed of a heat settable material as an alternative material since both **Knight** and **DeCamp** disclose rubber materials that are both self-coiling to protect a cylindrical core.

6. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knight** in view of **Whittington**.

The patent to **Knight** does not disclose the protector as being formed from urethane. The patent to **Whittington** discloses a protective wrapping for an elongated member, wherein col. 3, lines 28 and 29 disclose that one suitable material for the wrapping is urethane rubber. This wrapping, once placed on a mold or mandrel is subjected to heat and pressure to cure or vulcanize the rubber layers, thus producing a wrapping having great resistance to radially outward deformation, and providing cushioning and protection from outside wear and abuse. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the rubber of Knight, a urethane material, as suggested by Whittington in order to produce a protector that will provide a cushioning for the protected member, and will prevent wear and abuse from the outside environment.

### ***Response to Amendment***

7. The examiner would like to thank Applicant for his patience and efforts in prosecuting this case. Regrettably, what was originally indicated as allowable was found not to be allowable as a result of art found by a review panel. The examiner suggested language that would overcome that particular reference, however after researching the art, it is believed that the claims are not patentable. The **Knight** reference, which is art of record, essentially discloses the invention, structurally in disclosing a self-coiling, elastomeric, abrasion resisting piece of material that functions



to cover and protect cylindrical objects, as shown in the figures. Though not utilized specifically in protecting ropes against abrasive surfaces, but it could function in that capacity. Other newly discovered references disclose that the present invention provide evidence that the present invention is not new or unobvious, as self-coiling devices for protecting cylindrical objects is known in the art. For instance U.S. 2,053,811 to **Boyle** discloses an abrasion resisting guard that that is disclosed as protecting conductors, but could very well protect webbings or ropes. Likewise U.S. 2,826,523 to **Blaszkowski et al.** also discloses a protective covering that has a memory in a spiral shape that could likely be utilized to protect a rope or webbing. There is nothing specific about the present invention that would limit it to the use of protecting ropes and therefore, the reference to **Knight**, as well as the references to **Blaszkowski et al** and **Boyle** suggests that the invention is not patentable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (571) 272-4897. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick F. Brinson  
Primary Examiner  
Art Unit 3754

P. F. Brinson  
November 7, 2005

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